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OFFICE OF PETITIONS

In re Application of
Tanabayashi et al.
Application No. 09/786818
Patent No. 7010306
Attorney Docket No. 9682/82

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:DECISION GRANTING PTA
:RECONSIDERATION
:
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This decision is in response to patentees' REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT PURSUANT to 37 CFR 1.705(d) TIMELY FILED ON MAY 5TH requesting that the Office adjust the PTA at the time of the issuance of the patent from a determination of 535 to a determination of 1087 days. The Office has reviewed the determination and decided that the Office had in fact erred in reducing the PTA by 71 days for events occurring after the notice of allowance. The actual amount of reduction should have only been 25 days.

Patentees' letter regarding PTA is **GRANTED-in-part**. The proper amount of PTA at the time of the issuance of the patent is 581 days. The Office will sua sponte issue a certificate of correction reflecting this determination. The Office will also correct the PAIR determination to reflect this decision.

Patentees are given 30-days or one month whichever is longer to respond to this decision. No extensions of time are granted under 37 CFR 1.136.

Patentees' assert that the Office made two errors in the determination of the PTA. 1) The Office failed to provide any additional PTA for the Office's failure to issue the application within three years of the filing date. 2) The Office assessed too much PTA reduction under 37 CFR 1.704(c)(10). Patentees' assert that the Office should assess any additional PTA addition of 563 days¹ which is the amount of time from the three year anniversary date until the date of filing the RCE. Patentees further assert that the only delay under 37 CFR 1.704(c)(10) is the submission of the drawings.

Patentees' assertions are not persuasive. Patentees argument relating to 37 CFR 1.702(b) is not persuasive. Patentees are advised that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the

¹Patentees assert that the additional 563 days began on March 10, 2004 (day after 3-year anniversary date and ended on September 23, 2005, date of submission of RCE request.

application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). Because the PTA amount awarded under 37 CFR 1.704(a)(1) is greater than the delay under 37 CFR 1.702(b), applicants will receive no additional PTA time.

In addition, Patentees properly received a reduction of 25 days under 37 CFR 1.704(c)(10). However, the additional 46 days of reduction were in error. The Office addressed applicants' submission after the notice of allowance in the response on January 20, 2006 and accordingly the only delay after the mailing of the notice of allowance is for the period from 12/27/05 until 1/20/2006.

After the mailing of this decision, the patented file will be forwarded to the certificate of correction branch for a prompt issuance of a certificate of correction.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.

Kery A. Fries

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

cc: PTA determination

Draft Certificate of correction